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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,889	05/11/2006	Konrad Tetenborg	P71218US0	5028
136 7590 10/27/2010 JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 WASHINGTON, DC 20004				
EXAMINER HELVEY, PETER N.				
ART UNIT 3782		PAPER NUMBER		
MAIL DATE 10/27/2010		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/578,889

Applicant(s)

TETENBORG ET AL.

Examiner

PETER HELVEY

Art Unit

3782

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 9-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/GS/8)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 11/20/2006

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Invention 1 in the reply filed on August 12, 2010 is acknowledged. The traversal is on the ground(s) that US 6360916 does not teach the common technical feature of the claimed perforation lined that change shape across a heat seal. The examiner concedes this and withdraws the applied reference in view of *Warr* (US 5558438) teaching the same as applied below. The requirement is still deemed proper.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Specifically, the disclosure does not provide information on how one skilled in the art could construct a line of perforations that changes shape across a heat seal when it only exists on one side of the heat seal.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites limitations such as "the corner weld seal", "the centerline", etc. There is insufficient antecedent basis for these limitations in the claim. All claims contain many additional antecedent bases issues and should be reviewed and amended to correct such issues as exemplified above. Claims 2-8 are rejected for incorporating the indefinite limitations by dependency, as well as for containing similar antecedent basis issues.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Beer et al.* (US 5060803, hereinafter '*Beer*') in view of *Warr* (US 5558438).

Beer discloses a FFS-capable gusset bag comprising a tear-open perforation (46) at least in the area of one of the corners of the bag, wherein the bag comprises a cross-weld seal (40B) in the area of at least one corner.

Beer does not expressly disclose that the forming of the tear-open perforation in the area of at least one corner is changed in such a way that the perforation in the interspace between the edge of the bag and the corner weld seal is provided in a different manner as compared to the perforation between the corner weld seal and the centerline of the bag.

However, *Warr* teaches providing a tear open perforation that changes shape across a heat seal (Fig. 1, 23, 21).

Because *Warr* and *Beer* both teach tear opening perforations for the opening of a pouch, it would have been obvious to one of ordinary skill in the art to substitute the notch and line of perforations taught by *Warr* for the notch taught by *Beer* to achieve the predictable result of opening the pouch.

At the time of the invention, it further would have been obvious to a person having ordinary skill in the art to add the line of perforations taught by *Warr* to the bag taught by *Beer*, in order to provide an easy opening tear point that follows a more predictable path (col. 4, ll. 15-30).

The examiner notes that the combination above results in a device wherein the length or the periphery of the perforation incision in the interspace between the edge of the bag and the corner weld seal is larger than the length of

the perforation incisions between the corner weld seal and the centerline of the bag, clearly also resulting in the opposite as well. Further, the perforations must be smaller than the diameter of the material inside otherwise the bag wouldn't perform the intended function. In addition, because no material is claimed the material could be anything and clearly golf balls would not be capable of passing through any of the perforations in the combination if golf balls were the contents of the bag. The corner weld seal further comprises passages (after tearing is complete, allows pouring of material) and the line of perforations comprises one line.

Beer as modified by *Warr* discloses substantially all the limitations of the claim(s) except for the omission of the perforations between the weld seal and the centerline of the bag. It would have been obvious to one having ordinary skill in the art at the time the invention was made to eliminate a portion of the tear perforation line, since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the other top corner with the same weld line and tear open perforations, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

As a note, the examiner has interpreted all product by process and functional limitations in accordance with the MPEP and the combination recited above is considered to meet the scope of the claims.

It should be appreciated that the applicant's functional language in the claims does not serve to impart patentability. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. Apparatus claims cover what a device is, not what a device does. A claim containing a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior apparatus teaches all the structural limitations of the claims. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d, 1429, 1431-2 (Fed. Cir. 1997); Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990); Ex parte Masham, 2 USPQ 2d 1647 (Bd. Pat. App. & Inter. 1987).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PETER HELVEY whose telephone number is (571)270-1423. The examiner can normally be reached on M-Th 8:00 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Newhouse can be reached on (571) 272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. H./
Examiner, Art Unit 3782

October 23, 2010

/Nathan J. Newhouse/
Supervisory Patent Examiner, Art Unit 3782